

0 2 SEP 2008



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

MCDERMOTT WILL & EMERY LLP  
18191 VON KARMAN AVE.  
SUITE 500  
IRVINE CA 92612-7108

In re Application of	:	
BEBBINGTON et al.	:	
Application No.: 10/585,149	:	DECISION
PCT No.: PCT/US2004/043830	:	
Int. Filing Date: 30 December 2004	:	
Priority Date: 31 December 2003	:	
Attorney's Docket No.: 073678-0026	:	
For: TRANSACTIVATION SYSTEM FOR	:	
MAMMALIAN CELLS	:	

This decision is in response to applicants' "PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT," filed 17 April 2008 and the "SUPPLEMENTAL FILING IN SUPPORT OF PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT" filed 25 August 2008. The submissions have properly been treated as a single petition under 37 CFR 1.181. The petition filed 25 August 2008 requests that, in the alternative, the petition be considered a petition to revive under 37 CFR 1.137(a).

**BACKGROUND**

On 30 December 2004, applicants filed international application PCT/US2004/04380, which designated the United States and claimed a priority date of 31 December 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 July 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 30 June 2006

On 30 June 2006, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 26 March 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (FORM PCT/DO/EO/905).

On 27 March 2008, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT

(Form PCT/DO/EO/909) indicating that the application was abandoned for failure to timely respond to the Notification mailed 26 March 2007.

On 17 April 2008, applicants submitted the "PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT."

On 25 August 2008, applicants submitted the "SUPPLEMENTAL FILING IN SUPPORT OF PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT," which was accompanied by, *inter alia*, an incoming mail log for the law firm of petitioner.

### DISCUSSION

#### Petition Under 37 CFR 1.181

If applicants can establish nonreceipt of the NOTIFICATION OF MISSING REQUIREMENTS, then the application was never abandoned. In such case, the holding of abandonment will be withdrawn pursuant to 37 CFR 1.181. See MPEP § 711.03(c), para. I.A. The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Items (1) and (2) have been met.

As to item (3), MPEP § 711.03(c), para. I.A. states that a "copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action." Such a master docket report has not been provided. Rather, an incoming mail log for the firm for the period between 27 March 2007 and 10 April 2007 has been provided.

#### Petition Under 37 CFR 1.137(a)

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay must be filed promptly after applicant becomes aware of the abandonment, and such petition must be accompanied by: (1) A proper response, unless already filed; (2) The petition fee as set forth in 37 CFR 1.17(l); (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) A terminal disclaimer (if necessary).

Item (1) has been satisfied.

As to item (2), the petition fee has not been paid.

Item (3) has not been satisfied. Non-receipt of the Notification mailed 26 March 2007 has not been established. As noted above, a copy of the master docket report showing all replies docketed for a date two months from the mail date of the nonreceived Office action has not been provided.

### **CONCLUSION**

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

For the reasons set forth above, the petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The application remains abandoned.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

Daniel Stemmer  
PCT Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (571) 272-3301  
Facsimile: (571) 273-0459